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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,882	04/09/2004	Kenzo Sakurai	Q79368	9264
23373	7590	08/13/2008	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PADEN, CAROLYN A	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			08/13/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/820,882

**Applicant(s)**

SAKURAI, KENZO

**Examiner**

Carolyn A. Paden

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

Applicants' arguments relating to the Fessmann smoking generator are persuasive. Accordingly the rejection of the claims over Smits is withdrawn and prosecution of the application continues.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smits for reasons of record and further in view of the admitted state of the prior art taken with Kenzo.

Smits discloses liquid smoke concentrate. The concept of treating fish with treating fish is disclosed at column 3, line 39. The liquid smoke is made (column 3, lines 62-68 and column 4) by creating smoke and then removing the first and second tar fractions by cooling the smoke to a temperature of 150-200C and then to 80C to 120C. After cooling to room temperature, the non-condensable gases are separated off. Then the pH of the smoke is adjusted with water, acid or base. The claims appear to differ from Smits in the creation of a smoke dried fish but smoked foods are typically dried foods. To use the smoke of Smits in a dried fish formulation

would have been an obvious matter of choice with regard to the particular extent of preservation desired in the fish product. It is also appreciated that fish fillet is not mentioned but fish is typically prepared in fillets. Dipping fish in liquid smoke would have been an obvious way of introducing the liquid smoke to the fish.

Applicant urges that Smits does not disclose the use of a smoke-generating device into which no air is introduced. Smits uses a Fessmann smoke generator, which uses steam extraction of smoke components. Air may be introduced into the steam to adjust the moisture and flavor of the composition (page 2, column 2, lines 67-72). There is no suggestion that air is required in the composition of Smits. Applicant admits at pages 2-3 that the Japanese patent to inventor in 1996 provides a dry smoke flavor that is achieved without air. The dry smoke is extracted with water to provide a liquid smoke flavor. Kenzo also shows this specific smoke generator. It would have been obvious to use the smoke generator of Kenzo that omits air in Smits to prepare a smoking flavor without the flavor components introduced by air.

Applicant argues that Smits does not disclose removal of unnecessary substances. This is disagreed with as note column 3, lines

64-68 to column 4, lines 1-3. Change in pressure would be expected from the change in the temperature conditions used in Smits.

Claims 3-6 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smits in view of Kenzo and the admitted state of the prior art as applied to claims 1-2 above, and further in view of Kenzo (PAJ 10-179016).

The claims appear to differ from Smits in view of the admitted state of the prior art and Kenzo in the recitation of the use of perfusion through a blood vessel as a way of adding liquid smoke to the fish. Kenzo ('016) teaches that perfusion as a way to distribute antioxidants to fish. It would have been obvious to one of ordinary skill in the art to use the perfusion system of Kenzo in the fish processing of Smits in order to preserve the fish with liquid smoke. It is also appreciated that the use of an anti-coagulant is not mentioned in claim 8 but if one of ordinary skill in the art wanted to completely flush the blood from a fish, it would be obvious to use an anti-coagulant in the perfusion system. The preserved fish would still be suitable for consumption by rodent pests. It is also appreciated that frozen fish is not mentioned but to freezing is an obvious way to preserve the shelf-life of fish.

The rejection of the claims under 35 USC 112, first paragraph has been withdrawn in response to applicants' arguments and references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached by dialing 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Carolyn Paden/

Primary Examiner 1794